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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,455	12/03/2003	R. Resendes	PO-8011/PS-1121	6695
34947	7590	11/21/2006	EXAMINER	
LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112				TESKIN, FRED M
		ART UNIT		PAPER NUMBER
		1713		

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/726,455	RESENDES ET AL.	
	Examiner	Art Unit	
	Fred M. Teskin	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 4-10 is/are rejected.
- 7) Claim(s) 2 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

This Office action is responsive to the Reply of September 15, 2006. Claims 1, 2 and 4-10 are currently pending and under examination herein.

The rejection over Omura is withdrawn as moot, claim 1 having been rewritten to include the limitations of allowable claim 3 (now canceled).

The objection to the disclosure is withdrawn in view of the amendments to the Specification and applicants' representation that the Examples herein would be understood by one skilled in the art as representative of embodiments of the claimed invention. The objection under Rule 75(c) and rejection under 35 USC 112, 2nd paragraph, have been obviated by the amendments to claims 1, 4 and 5.

The objection to the abstract of the disclosure, not having been addressed in the Reply, is *maintained* as per the previous Office action (see p. 2, second paragraph). Correction is required. See MPEP § 608.01(b)(C).

Claims 1 and 4-10 are rejected under 35 U.S.C. 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed.

The deletion of "organic" from claim 1 broadens the noted claims to include *inorganic* nitro compounds beyond nitrous acid, i.e., H-NO₂, the only inorganic species

described herein. The claims would, for instance, literally read on inorganic nitrites of the type MNO_2 , the use of which is nowhere described, expressly or implicitly, in the specification as filed. The instant specification only imparts knowledge of polymerizing the recited monomers in the presence of at least one organic nitro compound (defined as inclusive of $H-NO_2$ at page 5, lines 8-16) and does not adequately describe the invention in terms of anything broader as is claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2001/0014726 to Langstein et al.

Langstein et al disclose low-gel, high molecular weight isoolefin copolymers derived from the requisite monomers (e.g., isobutene and isoprene) and possessing a multiolefin content and a M_w within the recitations of claims 8-10. See Table 2,

Examples 2b – 2h, wherein low gel content was achieved through the addition of a specific nitro compound (nitromethane) to the monomer solution before the beginning of the reaction.

It is acknowledged that the disclosed copolymers were made in the presence of vanadium compounds, which are excluded from applicants' process; however, the rejected claims are drawn to a polymer product and not its method of preparation. It is well settled that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. See, *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Instantly, the evidence of record fails to show that the claimed polymer differs substantially from the copolymer of Langstein et al as a result of vanadium compounds being absent from the polymerizing step.

Where, as here, a product-by-process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden properly shifts to applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 195 (Fed. Cir. 1983). This is especially true given the lesser burden of proof on the Office in making out a case of *prima facie* obviousness for product-by-process claims, because of their peculiar nature (M.P.E.P. 2113).

Claim 2 is objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim.

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Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

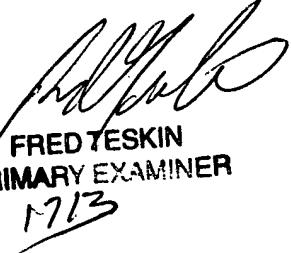
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FRED TESKIN
PRIMARY EXAMINER
1713

FMTeskin/11-16-06